

Application No. 10/552,858
November 12, 2009

REMARKS

Claim 3 – 5, 7 – 9, 20 and 21 are currently pending. Claims 5, 20, and 21 are the pending independent claims.

In the Office Action, Claims 20 and 21 were rejected under Section 112, first paragraph, as allegedly failing to comply with the enablement requirement, and under Section 112, second paragraph, as allegedly indefinite. Claim 4 was also rejected as allegedly indefinite.

Claim 2 was objected to as allegedly failing to further limit the claim from which it depends (Claim 20). Finally, Claims 3 and 8 – 9 were objected to as being dependent upon a rejected base claim, but the Examiner indicated these claims would be allowable if rewritten in independent form.

Each of the foregoing rejections is respectfully traversed. Favorable reconsideration is requested in view of the above amendments and following remarks.

I. Enablement / Indefiniteness Rejections of Claims 20 – 21.

As an initial matter, the Examiner contends that Claims 20 – 21 are indefinite and/or lack enablement.

First, the Examiner notes that Claims 20 and 21 recite an optional pair of steps in which the salt present is removed and hydrochloric acid is then added. The Examiner contends that the order of these steps is in error; i.e., the claim should require that hydrochloric acid be added first, and the salts then removed. Applicants appreciate the Examiner pointing out this discrepancy. In response, Applicants have amended Claims 20 and 21 to clarify the specified order of the acid addition and salt removal steps.

Second, the Examiner objects that the wording of HCl “from an aqueous acetonitrile solution” does not make sense. The Examiner suggests that the word “from” should be replaced by the word “in.” In response, Applicants have amended Claims 20 and 21 as suggested by the Examiner to specify that the hydrochloric acid is added “in an aqueous acetonitrile solution.” Once again, Applicants note their appreciation for the Examiner’s

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conscientious review of the claims and for pointing out yet another inadvertent syntax error.

The Examiner further contends that the letter “m” is undefined in Claim 20. In response, Applicants submit that the claim already defines m to be 1, but Claim 20 has been amended herein to make this clearer.

In addition, the Examiner also contends that Claim 21 is garbled in that it does not positively recite a step for reaction of compound IV with thiourea. Without this reaction, the Examiner contends that the compound of formula IV could not ultimately be converted into the compound of formula I.

In response, Applicants note the requirement in claim 21 as amended that the compound of formula IV be converted to the compound of formula V by removal of the silyl protecting group(s) and by providing that the compound of formula V is “cyclised” with thiourea. By reason of these steps, the claims now more clearly direct ultimate conversion of the compound of formula IV into the compound of formula I.

The Examiner also contends that the phrase “wherein optionally the compound of formula V” is unclear in Claim 21 because it lacks a verb. In response, Applicants have amended Claim 21 to specify that the compound of formula V “is formed.”

In view of these amendments, it is submitted that all alleged enablement / indefiniteness rejections has been overcome, and should be withdrawn. Action in accordance therewith is respectfully requested.

II. Indefiniteness Rejections of Claim 4.

The Examiner also contends Claim 4 is indefinite due to the reference to a “solvated form” in the claim. In the Examiner’s view, this should be referred to as a “hydrated form” rather than a “solvated form.” Without acknowledging the correctness of this assertion, Claim 4 has been amended to change the word “solvated” to “hydrated” in order to advance prosecution of the case. No change in meaning or scope is intended.

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In view of this amendment, it is submitted that the indefiniteness rejection has been overcome and should now be withdrawn. Action in accordance therewith is respectfully requested.

III. Objection to Claim 2.

Finally, the Examiner contends that Claim 2 is of improper dependent form because, in his view, it does not further limit Claim 20 from which it depends. Without acknowledging the correctness of this assertion, Claim 2 has been cancelled in order to advance prosecution. Accordingly, it is submitted that the indefiniteness rejection has been overcome and should now be withdrawn. Action in accordance therewith is respectfully requested.

In light of the foregoing, the present application is believed to be in condition for allowance. Entry of the amendments submitted herein and allowance of all pending claims is respectfully solicited.

In the event this response is not timely filed in accordance with any extension submitted herewith, Applicants hereby petition for the appropriate extension of time and request that the fee believed necessary for the appropriate extension along with any other fees which may be due with respect to this paper be charged to our Deposit Account No. 12-2355.

Respectfully submitted,
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